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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,025	09/01/2000	Mark L. Yoseloff	PA0463.ap.US	5837

29159 7590 06/22/2006

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EXAMINER	
MOSSER, ROBERT E	

ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/654,025	YOSELOFF ET AL.	
	Examiner	Art Unit	
	Robert Mosser	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

♦

This action is Non-Final responsive to the RCE filed 5-22-2006.

Claims 23-49 are pending.

♦

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 22nd, 2006 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **23, 27, 29-30, 33, 35-36, 38, 40-42, 45-46,** and **48** are rejected under 35 U.S.C. 102(e) as being anticipated by O'Halloran (US 6,439,993).

Claim **23, 29, 35, 38, 41, 45, 48**: O'Halloran teaches a method and apparatus for a video wagering game including:

allowing player placing a wager and select the win lines to play on a spinning reel-slot-type video game event having a plurality of symbol positions located on each win line (Abstract & Col 1:5-19);

displaying a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position on a reel (Abstract, Col 1:5-19, & Figure 1);

a plurality of winning conditions and awards associated with a plurality of the conditions(Col 1:12-16);

at least one wild function that is operable to assign a first characteristic to a first group of symbols in a first combination (or equivalently a first win line) that differs from the initial symbol characteristic("@" Col 2:60-3:9)., inoperable on a second combination (or equivalently a second win line) different from the first combination, and results in an increased likelihood of obtaining a winning condition (Col 2:46-3:17 & Figures 2-4);

upon the occurrence of a predetermined triggering event (Figure 2 Elm 30), randomly selecting between zero and fewer than a maximum number of viewable symbol positions (Fig 3 Elm 31) as a wild symbol position (Col 2:60-67);

converting (alternatively substituting or visually distinguishing) each symbol displayed within each selected wild symbol position to a wild symbol (Col 1:53-54; Fig 3

Elm 31) wherein the wild symbol operates on at least one but not all of the displayed game symbols (Fig 2,3,4,7; Col 2:48-54; Col 2:60-3:8); and

determining game outcomes based on the displayed game symbols and wild symbols and provide the player any awards associated with said game outcomes (Col 3:17-30).

Claims **33, 40**: The game of O'Halloran is further discloses the video wagering game as including processor for effecting the disclosed invention (Col 1:44-47) however, is silent regarding the incorporation of a data storage device for storing instructions utilized by the processor to effect the claimed invention as taught. The incorporation of memory in processor based gaming system is inherent feature without which the processor could not perform the disclosed invention of O'Halloran because the processor of O'Halloran would not have any instructions to execute and accordingly could in no way effect the system and method as taught be O'Halloran.

Claim **27, 30, 36, 42, 46**: O'Halloran teaches a method and apparatus for a video wagering game as taught above including the use of Wild symbols on a given win line or pay line independent of possible additional win lines being employed at the time of play (Col 1:29-54 & Figs 2-4). Accordingly the first and second combinations as presented correspond to the series of randomly selected symbols appearing across a first and a second payline of O'Halloran.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **24-26, 28, 31-32, 34, 37, 39, 43-44, 47,** and **49** are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US 6,439,993).

Claims **24-26, 32, 34, 39, 44, 49:** In addition to the invention of O'Halloran as taught above, O'Halloran is silent regarding the explicit teaching of a sequential or simultaneous unveiling of each of the symbols displayed at each one of the designated locations as wild symbols however, the Examiner gives ***Official Notice*** that the sequential or simultaneous unveiling of game outcomes is extremely old and well known in the art of gaming for drawing out the user's anticipation during game play and alternatively accelerate the process of game play resulting in comparatively faster game

play and increase operator revenue associated therewith . It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the sequential or simultaneous unveiling of each of the symbols displayed at each one of the designated locations as wild symbols in the prior art of O'Halloran as presented above in order to draw out the user's anticipation during game play or alternatively accelerate the process of game play resulting in comparatively faster game play and increase operator revenue associated therewith.

Claims **28, 31, 37, 43, 47:** In addition to the invention of O'Halloran as taught above, O'Halloran is silent regarding the explicit teaching of incorporating a server connected to the gaming device over a network for storing data related with the game however, the Examiner gives ***Official Notice*** that the utilization of a server in combination with a gaming device, connected through a network and utilized for storing information associated with the game is extremely old and well known in the art and used for purposes including but not limited to the incorporation of player tracking systems, fraud prevention/detection, monetary handling services include cashless play, and the incorporation of pari-mutuel prize pools. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a server connected to the gaming device over a network for storing data related with the game in order to allow additional game features including those listed in the preceding sentence to be implemented in conjunction with the gaming device of O'Halloran.

Response to Arguments

Applicant's arguments filed May 22nd, 2006 have been fully considered but they are not persuasive.

The Applicant present, "Applicants have amended independent Claim 23 to clarify the Claim language. Amended Claim 23 sets forth the following elements: "at least one wild function which is: (a) operable on a first one or more of the symbols in a first one of the combinations', (b) inoperable on one or more of the symbols in a second one of the combinations, the first combination being different from the second combination', and (c) operable to increase a Iikelihood of meeting at least one of the winning conditions." O'Halloran does not disclose such elements.", on page number 11 of their remarks submitted concurrently with the May 22nd, 2006 amendment. However, upon consideration of the amended claims the Examiner finds these limitations to be anticipated by the prior art of O'Halloran. Remaining claims are additionally subject to rejection under O'Halloran as presented above. Additionally and with respect to the Applicant's amendments and arguments associated therewith MPEP § 2114 set forth the following with regards to apparatus type claims:

APPARATUS CLAIMS MUST BE STRUCTUR-ALLY DISTINGUISHABLE FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429,1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus

claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material.

The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARK SAGER
PRIMARY EXAMINER

RM